

REMARKS

In response to the Office Action mailed August 21, 2003 and Advisory Office Action mailed December 16, 2003, Applicant respectfully requests reconsideration based on the above claim amendments and the following remarks. Applicant respectfully submits that the claims as presented are in condition for allowance.

Claims 3, 10-15, 18-47, and 51-61 were pending. Applicant have amended claims 15, 26, 40, 42, 44, 51, 54, and 56, cancel claims 41 and 43, and added new claims 62-66. After these amendments, claims 3, 10-15, 18-42, 44-47, and 51-66 are pending, of which claims 15, 26, 40, 42, 44, 51, and 62 are independent.

In the Office Action mailed August 21, 2003, claims 3, 10-15, 18, 21-30, 31, 34, 35, 44, 51, 54, and 56 were rejected under 35 U.S.C. 103(a) as being anticipated by Vass ("Going2 the wireless world – Wireless Web, road navigation technologies converge to get you where you need to be." PC Week, 68, March 20, 2000) ("Vass") in view of CellPoint ("CellPoint and Webraska Join Forces for New, Live Navigation Services Based on GSM Positioning of Cellular Phones," Business Wire, June 29, 2000) ("CellPoint"). Claims 40-43 were rejected under 35 U.S.C. 103(a) as being obvious over Vass. Claims 19, 20, 38, 39, 45-47, 52, 53, 55, 57, and 61 were rejected under 35 U.S.C. 103(a) as being unpatentable over Vass in view of CellPoint. Claims 32, 33, 36, 37, and 58-60 were rejected under 35 U.S.C. 103(a) as being unpatentable over Vass in view of CellPoint. To the extent any of these rejections might still be applied to claims presently pending in this application, they are respectfully traversed.

In the Advisory Office Action, the Examiner further alleged that Vass discloses wherein "Go2 lets consumers with mobile device find nearby business, such as coffee shops, hotels or

movie theatres,” by verifying use location and searching a database derived from yellow page information. The Examiner also alleged that ‘Vass teaches “searching a database derived from yellow page information aggregators to get the nearest outlets of some 15 million business.” Information aggregators would include business address – as is common in yellow page information – and to simply remove the address (location) would have been obvious to one of ordinary skill in the art at the time the invention was made.’ To support his assertions, the Examiner cited *In re Larson*, 340 F.2d 965, 144 USPQ 347 (CCPA 1965) and *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975).

Applicant respectfully traverses the above rejections based on the reasons below.

Amended claim 15 recites a system for providing location-based yellow pages information, wherein the process is configured to, among other things, receive a request for yellow page information from the user, the request including user measured location information that is determined using information obtained from a telecommunication system and a user selected advertiser category identifier, interactively communicate with the user to receive a user selected advertiser sub-category identifier, retrieve one or more advertiser entries from at least one of the first subset and the second subset of the plurality of advertiser entries based on at least one of the user measured location information, the user selected advertiser category, and the user selected advertiser subcategory. Similar amendments have been made to independent claims 26 and 44.

Amended claim 42 recites a method for providing a location-based yellow page service, comprising, among other things, receiving a request for yellow page information from a user, wherein the request including user measured location information and a user selected advertiser

category identifier, receiving a user selected advertiser category identifier, sending a user advertiser confirmation query to the user, wherein the user advertiser confirmation query includes one or more advertiser subcategories, receiving a user advertiser confirmation response from the user, wherein the user advertiser confirmation response include a user selected advertiser subcategory identifier, upon receiving the user advertiser confirmation response from the user, retrieving one or more first and second advertiser's information from the yellow database, presenting the one or more advertiser's information in a manner that the first advertiser's information are displayed prior to the second advertiser's information. Similar amendments have also been made to claim 40 and 51.

In the newly added claim 62, the processor is configured to receive a request for yellow page information from the user, the request including at least one of a user measured location information, a user selection of a category and a user selection of a sub-category, wherein the user is interactive communicable with the processor to refine the selection of the category and the sub-category, . . . , and presenting the one or more advertiser entries in an order that the advertiser entries with advertiser location information are presented prior to those lacking of advertiser measured location information.

The amendments to the claims have support in the specification at, for example, paragraphs [0030] to [0034] and [0043] to [0046]. Therefore, no new matter has been introduced.

Rejection under 35 U.S.C. 103(a)

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the

knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success.

Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P §2143.

Without conceding the first and second criteria, Applicant asserts that cited combination do not teach or suggest each and every elements of the claims.

Vass describes a wireless locator site that helps travelers find products and services while they are on the road. According to Vass, a consumer must enter his or her location via a street address. The street address is then translated into an eight-digit number representing the latitude/longitude coordinates. The consumer then inputs the service he or she is seeking by typing in either a generic category or a brand-specific products or service. The wireless locator site then identifies the nearest outlets. In addition, the system according to Vass delivers driving instructions and phone numbers to the consumer. As acknowledged in the Office Action, Vass fails to teach or to suggest "each advertiser entry of at least a second subset of the plurality of advertiser entries lacking advertiser measured location information."

~~For the obviousness rejections, the Examiner combines CellPoint with Vass. Cellpoint is~~
merely a news article relating a demonstration regarding a traffic information and navigation services on Internet mobile phones to be held during the Mobile Location Services and Applications Conference in London on July 6-7, 2001. The article describes, very vaguely, that "conference attendees will be able to witness the time and hassle savings associated with being automatically located on a map and then guided to a destination address or facility such as a restaurant, ATM, petrol station, drugstore, etc."

However, in the combinations of Vass and Cellpoint, there is no teaching or suggestion that a processor is configured to “interactively communicate with the user to receive a user selected sub-category identifier,” “retrieve one or more advertiser entries from at least one of the first subset and the second subset of the plurality of advertiser entries based on at least one of the user measured location information, the user selected category identifier and the user selected subcategory identifier, and present the selected one or more advertiser entries based at least in part on the user measured location information and the advertiser measured location information of the selected one or more advertiser entries,” as recited in claims 15, 26, 44, and 51 and similarly in claims 40, 42, and 62. Nowhere in Vass and CellPoint teaches or suggests that the user can interactively communicate with the processor to refine his selection of the advertiser category and subcategory.

Similarly, neither Vass nor CellPoint, whether taken singly or in any combination, teaches or suggest that the yellow page database includes a plurality of advertiser entries, wherein a first subset of advertiser entries comprises advertiser measured location information, and a second subset of advertiser entries lacks of advertiser measured location information, as described in claims 15 and 62, and a third subset of advertiser entries, as recited in claims 44 and 51.

Furthermore, in any combinations of Vass and Cellpoint, there are not teachings or suggestions that storing advertiser identifiers in at least each advertiser entry of a third subset of the plurality of advertiser entries, wherein the advertiser identifiers in the third subset lacks advertiser measured location information, as recited in claims 44 and 51.

Regarding the limitations of the second subset and third subset of advertiser entries, the Examiner cited *In re Larson* and *In re Kuhle* to assert that to simply remove the address (location) would have been obvious to one skilled in the art at the time the invention was made. Applicant respectfully disagrees. Contrary to the Examiner's assertion, the features of the second subset as recited in claims 15, 26, and 62 and third subset as recited in independent claims 44 and 51 are not to "remove" or "omit" a feature from a method and system, but rather to "add" or "further limit" a feature to the method and system. The added limitations enable the methods and systems of the present invention to perform different functions. For example, as described in the specification at, for example, paragraph [0044], "server 270 can present the advertisers for the selected category in a distance order with the closest advertiser presented first, the next closest advertiser presented next, and so on. In one embodiments, only advertiser having associated measured location information are presented to the user. . . . In another embodiment, advertisers having measured location information are presented first followed by advertiser lacking measured location information."

Accordingly, Applicant respectfully submits that it would not have been obvious for one skilled in the art to modify Vass with CellPoint to achieve the methods and systems as recited in the independent claims. Among other reasons, the combination of Vass and CellPoint simply fails to teach or suggest all the limitations of the independent claims of the present invention. Thus, the rejection of all of the pending claims under 35 U.S.C. 103(a) as being unpatentable by either Vass singly or by Vaas in view of CellPoint should be withdrawn.

Serial No. 10/026,836
Art Unit: 3629

Docket No. BS01-271
Page 25

In view of the foregoing, all of the claims in the present application are believed to be in condition for allowance. Should the Examiner have any questions or determine that any further action is desirable to place this application in even better condition for issue, the Examiner is encouraged to telephone applicants' undersigned representative at the number listed below.

SHAW PITTMAN LLP

Respectfully submitted,

1650 Tysons Boulevard
McLean, VA 22102
Tel: 703/770-7900

JAMES C. BEDINGFIELD, SR.

Date: January 21, 2004

By:


Wan-Ching Y. Montfort

AB/CYM

Document #: 1267155 v.1
